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EXAMINER	
MOONEYHAM, JANICE A	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/615,351	ZADROZNY ET AL.	
	Examiner	Art Unit	
	Janice A. Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 August 2005 and 09 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-14,16-23,46,48-56 and 82* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-14,16-23,46,48-56 and 82* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on August 15, 2005 and January 9, 2006, wherein:

Claims 1, 4-14, 16-23, 46, 48-56 and 82 are currently pending.

2. ***NOTE:*** Applicant's amendment filed on August 15, 2005 necessitated the new ground(s) of rejection presented in the Office Action mailed November 3, 2005. Applicant response filed January 9, 2006 stated that the prior art used for the new grounds of rejection, (Varma - US patent 6,564,246), is an invalid reference under Section 103(c) since the subject matter of the reference and the claimed invention were, at the time of the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Therefore, the final rejection mailed November 3, 2005 is ***withdrawn***.

3. A new grounds for rejection necessitated by the applicant's amendment submitted on August 15, 2005 is hereby presented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 4-14, 16-23, 46, 48-56 and 82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable

one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant has amended independent claims 1, 14, 46, 52, and 82 the language "***determining by the first computing device a confidentiality level for the proposal for inventions,***" "***wherein information is provided in the forum according to a level of confidentiality,***" "***a security system structured and arranged for determining a confidentiality level for the proposal for invention, for maintaining records regarding confidentiality levels and authorizing access to secured information, the security system including at least one microprocessor.***" The above subject matter has not been described in the specification in such a way as to enable one skilled in the art to make and/or use the invention without undue experimentation. For example, page 13 of the specification states that *the individuals with the appropriate confidentiality level and co-inventor requirements are selected in step 210.* Page 16 of the specification states that *the Security System 150 keeps records regarding confidentiality levels and authorized access to secured information. Each employee, or user of the corporate network 105, has a record in the Security System 150 describing their confidentiality level, login name, passwords and event history.* On page 28 of the specification, the applicant states that *[u]nder "Co-Inventor Requirements" in Figure 6, are the requirements used to search the subscriber database to create the potential co-inventor pool. The "Level of*

Confidentiality" field stores the level of confidentiality determined by the Security System. In this example, the confidentiality levels are internal, confidential, and top confidential. However, there may be many more gradations and conditions in the confidentiality levels. On page 29 of the specification, applicant states that *most of these fields, except "Level of Confidentiality", are filled in by the initial inventor in the preferred embodiment.* On page 31 of the specification, the applicant states that "*the Security System 150 may have a central processing unit (CPU) which uses a heuristic analysis program to weigh these factors and determine an appropriate confidentiality level. On the other hand, the Security System 150 may analyze the data and present a report to a patent proposal committee or patent proposal manager, who determines the appropriate security level of confidentiality based on their knowledge of the situation and contact with other managers in the corporation. In short, the Security System 150 represents any type of system, computer or human which designates a confidentiality level for a patent proposal.* On page 32 the applicant states that the *decrypted patent proposal input file 704 is sent to a Security Information Extractor 715, which extracts security information necessary for the Security System 150 to determine the appropriate level of confidentiality.*

This disclosed subject matter does not enable one skilled in the art to make or use the invention without undue experimentation. The levels of confidentiality have not been identified. The criteria for determining the levels

of confidentiality have not been identified. What is an appropriate confidentiality level? How is this determined? What information is used to determine the confidentiality level? Claims 4-13 are dependent on claim 1, claims 16-23 are dependent on claim 14, claims 48-51 are dependent on claim 46, claims 53-56 are dependent on claim 52. These claims therefore inherit the deficiencies of claims 1, 14, 46, 52, and 82.

5. Claims 49-51 and 54-55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant has amended the claim language to read "using a computing device structured and arranged for collecting a fee." The Examiner respectfully request the applicant to direct the Examiner to the lines and page of the specification where it is disclosed that the computing device is structured and arranged for collecting a fee. Page 12 of the specification simply states, *[i]n an Internet embodiment, people could subscribe to one or all of the services by paying a fee.* This language does not support a computing device structured and arranged for collecting a fee.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 14 and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al (US 2001/0034630) (hereinafter referred to as Mayer) in view of Takano et al (US 6434,580) (hereinafter referred to as Takano).

Regarding Claims 14,16 and 20:

Mayer discloses a system, the system comprising:

- a network of a plurality of computing devices (Figure 1 (10), page 2 [0023]);

a server for receiving information and for creating a pool (Figure 1 (12), page 3 [0037] page 5 [0082-0083]) ;

- a computing devices for transmitting information to the server over the network. (Figure 1 (20)(30), page 2 [0023] *Figure 1 depicts a computer network 10 through which remote devices 20,30 may communicate with one or more host servers 12*); and
- a database/file for storing records (profiles) (page 3 *server 12 stores a database program which maintains one or more databases such as candidate profile database and job profile database*)

- wherein the server (12) is capable of sending a message to the pool over the network, matching criteria or qualifications and candidates; and creating (proposal/job profiles) files (Figure 4 job profiles (37), candidate profiles (36); [0037] *abstract - matching candidate information may be presented to the employer in response to a search query*; Figure 4 Profile Matching Engine; page 1 [0010] *provides an interactive employment system which allows a candidate to enter profile data and to match their criteria* [0011] *candidate can be contacted via an e-mail message or an instant message transmitted to the candidate's browser*);
- wherein the server (12) creates a file (database of stored information) (page 3 [0037] *server stores a database program and maintains one or more databases such as candidate profile database (36) and a job profile database (37). The database program stores candidate profile data, job profile data and the like*).

The language *for receiving a proposal for invention and for creating a pool of co-inventors from group of subscribers,* is intended use of the system. A recitation directed to the manner in which a claimed system is intended to be used does not distinguish the claimed system from the prior art if the prior art has the capability to so perform. In the case, Mayer is fully capable of transmitting a proposal. The databases in Mayer are fully capable of storing subscriber records with a subscriber name, contact information, etc.

Mayer does not explicitly disclose a system structured and arranged for determining a confidentiality/access level for the invention, for maintaining records regarding the confidentiality/access level and authorizing access to the information.

However, Takano discloses a security system structured and arranged for determining a confidentiality/access level for the invention, for maintaining records regarding the confidentiality/access level and authorizing access to the information (*col. 7, lines 13-26 fields for entering a piece of invention report information and file name including a reference number of draft data, an employee ID number etc; col. 8, lines 7-24* ***displays on a display unit a list of all pieces of invention report information register in this table 304 (or only those satisfying specific conditions [e.g. only those pertaining to inventors belonging to a specific department]***; *col. 10, lines 8-29* ***only those pertaining to the inventor concerned***).

It would have been obvious to one of ordinary skill in the art to incorporate into the matching system of Mayer the draft data display of Takano so that only those persons satisfying specific conditions or only data pertaining to a particular inventor are displayed for the user.

Regarding Claim 17.

Takano discloses a system wherein the server (300) further comprises a means by which a user can access the file and a means by which a user can add data to the file

(*col. 8, 25-32 pieces of invention report information displayed on the display unit; any desired piece of invention report information can be selected by entering the piece number; col. 10, lines 8-51 the inventor, if he or she finds it necessary to* ***modify*** *the revised draft data, modifies the revised draft data*).

Regarding Claim 18:

Mayer discloses a system further comprising:

a web server for providing at least one web page accessible over the network, said web page comprising a means to access and add data to a file over the network (Figure 1 (12); page 2 [0024] *server 12 maintains a web site which is hosted by the Internet. A candidate or employer communicates with the server through remote terminals (20, 30)*; page 3 [0043] *host server 12 can direct any remote computing devices 20,30 to display an appropriate interface such as one or more pre-formatted web pages so that a user can interact with the server)*.

Regarding Claim 19:

Mayer discloses a system further comprising a computing device for transmitting information to a database (remote Terminals 20,30 and Network Connection (14), page 2 [0023] (Figure 1)).

Regarding Claim 21-23:

Mayer discloses a system wherein the server adds individuals to the pool by searching a database for a candidates that match qualifications and eliminates candidates that do not meet the qualifications (page 5 [0082][0083], *the server compares the search criteria to the candidate profiles stored in the database 36 and lists candidates who match the search criteria* (Figure 4 step 92) (Thus, those that do not match are eliminated or not listed).

The confidentiality level set forth in claim record is interpreted by the Examiner to be criteria used to make the match. Since claim 14 is directed to a system, the fact that the records also include a confidentiality level as a criteria is determined to be non-functional descriptive data and cannot render non-obvious an invention that would have otherwise been obvious. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The data in the record does not alter the structure of the system or how the computer functions, i.e. matching criteria with qualifications.

7. Claims 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over www.inventors.net retrieved from the Internet Archive Wayback Machine (hereinafter referred to as InoNet) in view of Tadayon et al (US 2004/0249902) (hereinafter referred to as Tadayon).

Regarding Claim 52:

InoNet discloses method of providing support for the development of inventions of a plurality of inventors over a network, the method comprising the steps of:

providing a secured forum on a network for a pool of potential co-inventors and an initial inventor to communicate and to further develop proposal for invention (page 1 *virtual network of inventors world-wide, a place of collaboration and collective magic*; page 4 *from its database InoNet chooses a group of 8-10 inventors*; page 7 *conducted in a secure electronic environment*, page 8 *InoNet selects potential team members from the InoNet database of inventive people*), the proposal being submitted by a first client/inventor (page 4 *the client company provides a full, confidential description of the problem to be solved*), wherein at least one of the inventors in the pool develops a part of the invention (page 4 *from its database, InoNet chooses a group of 8-10 inventors to work on the problem*; page 5 *inventors may be able to offer patented solutions for the proplem*).

InoNet does not disclose information being displayed according to a level of confidentiality.

However, Tadayon discloses a distributed file system which allows access to files by remote authorized users by using predetermined rules that enable the active virtual file system to be used in workflow automation [0012] which has an "Access Rights" function which inspects information previously store pertaining to this particular user (which

could include a level of confidentiality) [0016] ([0001] *the invention is specifically disclosed as a web-based active virtual file system that controls the access rights of users to files stored on the server [0006] once the user has been authenticated, the file system 50 will determine what access rights this particular user will have [0070-0071] as in conventional network servers, virtually the first thing that must occur when a user initially communicates to a distributed file system is to determine whether or not the user has any right to be logged into the file system. Once the user has been property authenticated, this user's access rights must be determined and the WAVFS 150 uses an "Access Rights" function 162 for this purpose. The user's access rights are represented by information that has been stored in the WAVFS 150 pertaining to this particular user).* The Examiner asserts that the information stored could encompass a confidentially level.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the problem solving service discloses in InoNet with the distributed file system access rights as taught in Tadayon to be able to monitor and control certain actions by users and to control the access rights of users to the files by determining whether or not the user has any right to be logged into the system and what rights the user has once authenticated.

Regarding Claim 53:

InoNet discloses a method wherein the step of providing a forum further comprises a step of providing at least one web page as the forum (InoNet is a website, *a virtual network of inventors using the intellectual power of the web to provide online problem solving sessions, this is the place for creativity,* ***collaboration*** *and collective magic;* page 1).

InoNet does not disclose the web page being stored on the server. However, Tayadon discloses a web-based active file system that controls access rights of users to files stored on the file server [0001].

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Tayadon with the collaboration disclosure of InoNet so as to provide a distributed file system that is web-based so as to allow remote users to use standard web browser software to access files in a central active virtual file system.

8. Claims 54-56 rejected under 35 U.S.C. 103(a) as being unpatentable over InoNet and Tadayon as applied to claim 52 above, and further in view of Mayer et al (2001/0034630) (hereinafter referred to as Mayer).

Regarding Claim 54:

InoNet discloses a method further comprising submitting a registration form to be included in databank of inventive people. Neither InoNet nor Tayadon disclose obtaining fees by a fee collection system.

However, Mayer discloses obtaining fees by a fee collection system as shown in Figure 4 where the employer pays to unlock candidate identification and page 3 [0042] which identifies the web site host charging fees.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include obtaining fees as taught by Mayer with the collaboration disclosure of InoNet and Tayadon so as to generate revenue to run the job-placement web site business.

Regarding Claim 55:

InfoNet discloses a website for inventors which creates a pool of co-inventors (page 4 *from its database, InoNet chooses a group of 8-10 inventors*).

InfoNet nor Tayadon disclose a fee collection system in which a fee is obtained from the initial inventor/company entitling the inventor to obtain information concerning the pool of potential co-inventors.

However, Mayer discloses the employer paying a fee to unlock the identification and contact data of the candidates (page 5 [0084])

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the payment of fees by the employer as taught by Mayer with the collaboration disclosure of InoNet and Tayadon so as to generate revenue on the basis of the number of qualified candidates that employers actually find through the use of the web site rather than charging for all candidates that match a particular job description so more employers will continue to use a job placement web site since the amount of money they are charged is proportional to the number of suitable and desirable candidates that the employer finds through the web site.

Regarding Claim 56:

InoNet discloses the secured forum is on the Internet (InoNet retrieved from the Internet Archive Wayback Machine)

9. Claims 1, 4-6, 8-13, 46, and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over InoNet in view of Mayer et al (US 2001/0034630) (hereinafter referred to as Mayer) and further in view of Tayadon et al (US 6,564,246) (hereinafter referred to as Tayadon).

Regarding Claims 1 and 46:

Inonet discloses a method for supporting the development of inventions (InoNet offers an on-line problem-solving service for inventors and people working with intellectual property), the method comprising the steps of:

- creating, by a computing device, a subscriber list (page 1 *users register with InoNet* (subscriber) and are included in *a databank of inventive people*) comprising records having at least a name, contact information (see pages 9-13 *registration information includes name and contact information*), and qualifications (pages 12-13 *Special Expertise and Education*);
- storing said list in a database (page 1, InoNet is a databank of inventive people, page 4 from its database, InoNet chooses a group of 8 to 10 inventors) ;
- receiving, by the computing device a proposal (page 4 *technology, product, process or packaging problems are submitted*)
- The Merriam Webster online dictionary retrieved from Onelook.com defines a proposal as:

> Main Entry: **pro·pos·al**
> Pronunciation: pr&-'pO-z&l
> Function: *noun*
> **1 :** an act of putting forward or stating something for consideration
> **2 a :** something proposed **:** **SUGGESTION** **b :** **OFFER**; *specifically* **:** an offer of marriage

The Examiner interprets submitting a problem needing a solution as an act of putting forward or stating something for consideration, i.e., a proposal. Furthermore, the

applicant states on page 27 of the specification *[t]he "**Problem Formulation**" field stores a short synopsis of the reasons or motivation for the patent idea. In order to make the system user-friendly, the **problem formulation** can have bullet categories to choose from, such as "a need for", "a lacking".*

- creating, by the computing device a pool of co-inventors (page 4 *InoNet chooses a group of 8-10 inventors from its database*) by searching for records in the list (*databank of inventive people*) with qualifications matching the desired co-inventor qualifications (see page 7 *the database of inventive people is scanned and a diverse team of highly qualified people are assembled*, page 8 *the potential team members are selected by InoNet in cooperation with the client company*), wherein said co-inventors in the created pool develop the invention described in the proposal (see page 3 - *problems (proposal) find solutions (invention)*).
- providing a forum for the pool of inventors to communicate and develop the proposal for the invention (page 1, *this is a place for creativity, **collaboration** and collective magic*; page 4 and page 7 *-the problem solving sessions takes place in a secure online environment*)

InfoNet does not disclose a step of contacting, by the computing device, the subscribers in the pool or the step of submitting the desired qualifications or storing the desired qualifications in a database.

However, Mayer discloses

- a step of contacting by the computing device the subscribers (candidates) in the pool (page 1 [0011] *the candidate can be contacted via an e-mail message, an instant message transmitted to the candidate's browser, and the like*; also see page 4 [0047] and [0077])
- the step of submitting the desired qualifications (page 5 [0080] and [0081] *employer may then conduct a search for possible candidates for a job position by entering search criteria* (qualifications)) and creating (submitting) a set of qualifications (page 3 [0037] *server stores a database program which maintains one or more databases, such as a job profile database* 37), page 5 [0080] *a process by which an employer may submit job profile data)*;
- the step of storing the desired qualifications in a database (page 3 [0037] *server 12 preferably stores a database program which maintains one or more databases, such as candidate profile database 36 and job profile database* 37)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the submission of candidate profile information and the step of contacting candidates as taught by Mayer with the disclosure of InoNet since the Internet is being used to match job candidates and employers with increasing frequency and the system allows an employer to search profile data corresponding to a plurality of candidates and return results corresponding to candidates who match the search criteria with increased

efficiency and speed, as opposed to a manual search, and to quickly notify the candidates without the candidates having to wait for a letter or fax.

Neither InoNet nor Mayer disclose determining a confidentiality/access level for the proposal or wherein information is provided in the forum according to a level of confidentiality/access.

However, Tadayon discloses a distributed file system which allows access to files by remote authorized users by using predetermined rules that enable the active virtual file system to be used in workflow automation [0012] which has an "Access Rights" function which inspects information previously store pertaining to this particular user (which could include a level of confidentiality) [0016] ([0001] *the invention is specifically disclosed as a web-based active virtual file system that controls the access rights of users to files stored on the server [0006] once the user has been authenticated, the file system 50 will determine what access rights this particular user will have [0070-0071] as in conventional network servers, virtually the first thing that must occur when a user initially communicates to a distributed file system is to determine whether or not the user has any right to be logged into the file system. Once the user has been property authenticated, this user's access rights must be determined and the WAVFS 150 uses an "Access Rights" function 162 for this purpose. The user's access rights are represented by information that has been stored in the WAVFS 150 pertaining to this*

particular user). The Examiner asserts that the information stored could encompass a confidentially level.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the problem solving service discloses in InoNet with the distributed file system access rights as taught in Tadayon to be able to monitor and control certain actions by users and to control the access rights of users to the files by determining whether or not the user has any right to be logged into the system and what rights the user has once authenticated.

Regarding Claim 48:

InoNet discloses a method further comprising providing, by the computing device, a forum for the pool to communicate and to further develop the proposal (page 1, *this is a place for creativity,* ***collaboration*** *and collective magic*; page 4 and page 7 *-the problem solving sessions takes place in a secure online environment*)

Regarding Claim 4.

InoNet discloses a method wherein the proposal is transmitted over the network (page 1 InoNet, *The Innovator's Electronic Network*, page 7 *the problem solving sessions takes place in a secure online environment).*

Regarding Claim 5.

InoNet does not disclose a method wherein the step of creating a pool is performed by a server.

However, Mayer discloses wherein the step of creating a pool is performed by a server (Figure 1 (12); page 5 [0082, 0083] *the server compares the entered search criteria to the candidate profiles stored in the candidate profile database 36. The server next lists candidates who match the entered search criteria* (Fig. 4 (92)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of the server performing the function of creating the pool as taught by Mayer with the disclosure of InoNet since the Internet is being used to match job candidates and employers with increasing frequency and the server cooperates to maintain the system and perform the method with increased efficiency and speed.

Regarding Claim 6:

InoNet does not disclose method wherein the step of contacting subscribers is performed over the network.

However, Mayer discloses contacting subscribers (*candidates*) over the network (page 1 [0011] *candidate can be contacted by an email message, an instant message transmitted to the candidate's browser, an the like*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the contact teachings of Mayer with the disclosure of InoNet since an email or instant message would allow the candidates or subscribers to be notified of the match quicker and more efficiently than would be a notification sent by regular mail as a letter, or delivered by fax or phone.

Regarding Claim 8:

InoNet discloses a method wherein the step of providing a forum further comprises a step of providing at least one web page as the forum (InoNet is a website, *a virtual network of inventors using the intellectual power of the web to provide online problem solving sessions, this is the place for creativity,* ***collaboration*** *and collective magic;* page 1).

InoNet does not disclose the web page being stored on the server

However, Mayer discloses a web page stored on a server (page 2 [0023] and [0024], page 3 [0043-0045]).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Mayer with the disclosure of InoNet since the server cooperates to maintain the network system and perform the steps of the method and

enables a candidate or an employer to interact with the server with one or more pre-formatted web pages.

Regarding Claim 9:

InoNet discloses a method wherein the step of creating a subscriber list further comprises a step of:

contacting, by an individual using a computing device, a subscriber database (page 1, *join our databank of inventive people, Register Now (hyperlink));*

creating a subscriber record for the individual on the subscriber database (pages 1 and 9-13, *once registered the subscriber joins the databank of inventive people*);

inputting, by the individual, information including a name of the individual, contact information of the individual, and qualifications of the individual into the subscriber record (page 9-13 *name, area of interest, company affiliation, academic affiliation, special expertise, working style, education*); and

storing the subscriber record on the subscriber database (page 1 *databank of inventive people*, page 7 *database of specialist*).

Regarding Claim 10:

InoNet does not discloses a method wherein the step of creating a subscriber list comprises establishing non-subscriber criteria; using said non-subscriber criteria to select individuals, creating non-subscriber records for said selected individuals, each of said non-subscriber records including information about a selected individual; and maintaining said non-subscriber records on a non-subscriber database.

However, Mayer discloses a method wherein the step of creating a subscriber list comprises establishing criteria (page 5 [0080, 0081] *employer submits job profile data and search criteria at web site hosted by server 12*); using the criteria to select individuals candidates (page 5 [0082] *the server then compares the entered search criteria to the candidate profiles stored in candidate profile database*), creating records for said selected individuals including information about a selected individual (*candidate profile* Figure 4); and maintaining the records in a database (page 3 [0037] *candidate profile database (36)*).

Mayer does not disclose that the candidates are non-subscribers. However, the type of candidates is determined to be non-functional descriptive data. Nonfunctional descriptive data cannot render non-obvious an invention that would have otherwise been obvious. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The steps of creating the list by matching criteria would be performed the same regardless of the type candidate.

Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of Mayer with the disclosure of InoNet since the Internet is being used to match job candidates and employers with increasing frequency and the system allows an employer to search profile data corresponding to a plurality of candidates, thus expanding the search, and return results corresponding to candidates who match the search criteria with increased efficiency and speed, as opposed to a manual search.

Regarding Claim 11:

Mayer discloses adding individuals (*candidates*) to the created pool of co-inventors by searching said database for candidates that match desired qualifications (Page 5 [0080-0083]).

Regarding Claims 12 and 13:

Both InoNet and Mayer disclose a databank of inventive people (InoNet page 1) and candidate profile database (Mayer Fig. 2B (36)). Mayer and Inonet further disclose information such as contact information, employment type, education, and background data (InoNet pages 9-13, Mayer pages 3-4 [0047-0054] and page 5 [[0065-0074])

Neither InoNet or Mayer disclose a record including a confidentiality/access level or a method wherein the confidentially level is used to eliminate a subscriber.

However, the confidentiality level would be a qualification or criteria by which the match is performed. Thus, it is determined to be non-functional descriptive data. Nonfunctional descriptive data cannot render non-obvious an invention that would have otherwise been obvious. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). Since the confidentiality level is a qualification or criteria by which the match is performed, the steps of matching the criteria with the qualifications would be performed the same regardless of what type information was entered as a qualification or criteria.

Therefore, it would be obvious to incorporate into the teaching and disclosure of InoNet and Mayer a field on the registration page or pre-formatted web page which allowed confidentiality information to be entered since intellectual property is an asset that is protected by companies and inventors and a company would not want to risk losing the potential asset to a competing company by allowing access to the information to someone who is not trustworthy, thus this person would be eliminated by the system since his/her confidentiality level would not match the criteria/qualifications necessary to make the list of potential candidates or inventors.

Regarding Claim 49:

InoNet discloses a method further comprising submitting a registration form to be included in databank of inventive people. InoNet does not disclose obtaining fees by a fee collection system.

However, Mayer discloses obtaining fees by a fee collection system as shown in Figure 4 where the employer pays to unlock candidate identification and page 3 [0042] which identifies the web site host charging fees.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include obtaining fees as taught by Mayer with the disclosure of InoNet so as to generate revenue to run the job-placement web site business.

Regarding Claim 50:

InfoNet discloses a website for inventors which creates a pool of co-inventors (page 4 *from its database, InoNet chooses a group of 8-10 inventors*).

InfoNet does not disclose a fee collection system in which a fee is obtained from the initial inventor/company entitling the inventor to obtain information concerning the pool of potential co-inventors.

However, Mayer discloses the employer paying a fee to unlock the identification and contact data of the candidates (page 5 [0084])

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the payment of fees by the employer as taught by Mayer with the disclosure of InoNet so as to generate revenue on the basis of the number of qualified candidates

that employers actually find through the use of the web site rather than charging for all candidates that match a particular job description so more employers will continue to use a job placement web site since the amount of money they are charged is proportional to the number of suitable and desirable candidates that the employer finds through the web site.

Regarding Claim 51:

InoNet discloses a method further comprising the step of :

using a subscriber criteria (page 8 *InoNet, in cooperation with the client company selects potential team members*) supplied by the corporation (page 6 *corporate R&D*, page 7 *Who uses the service? Medium to large corporations*) and creating a pool of co-inventors (page 8 *after scanning a database of inventive people, a diverse team is assembled*, page 4 *from its database, InoNet chooses a group of 8 to 10 inventors*).

InoNet does not disclose obtaining a fee.

However, Mayer discloses a fee being paid (page 5 [0084] *employer pay a fee to unlock identification and contact data*) and *a web site host capable of charging further fees* (page 3 [0042]).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine obtaining fees as taught by Mayer with InoNet since

Mayer states there is a need for an interactive employment system and method which generates revenue on the bases of the number of qualified candidates that employers find through the use of a job-placement website.

10. Claim 82 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al (US 2001/0034630) (hereinafter referred to as Mayer) in view of InoNet and further in view of Tayadon.

Regarding Claim 82:

Mayer discloses computer system, the computer system comprising:

at least one computer-readable memory including (Figure 2A (25), page 3 [0034-0037] *the memory 25 may be an internal or external large capacity device for storing computer processing instruction, computer-readable data, and the like, server 12 includes a processor 31 and a memory 35 which may store one or more operating system and application programs*):

- code for maintaining a database structure of a list with records including a name, contact information, and qualifications (page 3 [0037] *server 12 stores a database program which maintains one or more databases, such as candidate profile database and job profile database*),
- code for searching for records in the list with qualifications matching a set of desired qualifications for the invention proposal (page 5 [0080-0083] *server then compares the entered search criteria to candidate profiles and lists candidates who match entered search criteria)* ,

- code for creating a pool from the records that match a set of desired qualifications ((page 5 [0080-0083] *server then compares the entered search criteria to candidate profiles and lists (pools) candidates who match entered search criteria*) ,

Mayer does not disclose:

- code that maintains forum being accessible to the pool
- code for receiving a proposal for an invention.

However, InoNet discloses:

- code that maintains forum being accessible to the pool (page 4, *from the database of inventive people, InoNet chooses a group of 8-10 inventors* (pool), page 1, *this is a place for creativity,* ***collaboration*** *and collective magic*, page 4 and page 7 – *the problem solving sessions take place in a secure online environment* (forum))
- code for receiving a proposal for an invention (page 4 – *technology, product process or packaging problems* (proposal is the problem needing a solution) are submitted).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the collaborative and problem solving teachings of InoNet with the disclosure of Mayer since companies can no longer depend only upon in-house resources for answers to problems, they need a place where problems find solutions and innovators find a community of like-minded people to collaborate to solve complex

problems, assemble a diverse team of highly qualified people for several disciplines and industries and tap into creative resources of inventors all over the world .

Neither InoNet nor Mayer disclose code for determining a confidentiality/access level for the proposal or wherein information is provided in the forum according to a level of confidentiality/access.

However, Tadayon discloses a distributed file system which allows access to files by remote authorized users by using predetermined rules that enable the active virtual file system to be used in workflow automation [0012] which has an "Access Rights" function which inspects information previously store pertaining to this particular user (which could include a level of confidentiality) [0016] ([0001] *the invention is specifically disclosed as a web-based active virtual file system that controls the access rights of users to files stored on the server [0006] once the user has been authenticated, the file system 50 will determine what access rights this particular user will have [0070-0071] as in conventional network servers, virtually the first thing that must occur when a user initially communicates to a distributed file system is to determine whether or not the user has any right to be logged into the file system. Once the user has been property authenticated, this user's access rights must be determined and the WAVFS 150 uses an "Access Rights" function 162 for this purpose. The user's access rights are represented by information that has been stored in the WAVFS 150 pertaining to this*

particular user). The Examiner asserts that the information stored could encompass a confidentially level.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the problem solving service discloses in InoNet with the distributed file system access rights as taught in Tadayon to be able to monitor and control certain actions by users and to control the access rights of users to the files by determining whether or not the user has any right to be logged into the system and what rights the user has once authenticated.

11. **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over InoNet, Mayer, and Tayadon as applied to claim 1 and InoNet and further in view of Eisenhart (2001/0047276) (hereinafter referred to as Eisenhart)**.

Regarding Claims 7 and 53:

Inonet does not explicitly disclose a server or each of the computing devices accessible by one or more subscribers in the pool.

However, Eisenhart discloses a method wherein the step of providing the forum (technology exchange and collaboration) is performed over the network by a server (Figure 2 (242) contributor server, page 3 [0035] (contributor is one contributing to the commercial development of the technology page 1 [0006]), each of said plurality of

computing devices being accessible by one or more subscribers in the pool of co-inventors (contributors) (page 4 [0042])

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the server as taught in Eisenhart with the disclosure of InoNet so as to allow the contributor to use his/her computer and the connection between the server and the Internet to register with and access the technology exchange system.

Response to Arguments

12. Applicant's arguments filed on August 15, 2005 and January 9, 2006 have been fully considered but they are not persuasive with the exception of the argument regarding prior art, Varma.

Applicant states that the various pages of the InoNet reference have various publication dates and because of this that the various pages should be considered in separate references. The Examiner respectfully disagrees with the applicant as to this line of reasoning. The applicant's priority date is July 12, 2000. The dates of the InoNet reference are at the bottom of each page. The dates of pages 1 and 2 are January 25, 1999, the dates of pages 3-13 are October 9, 1999 and the dates of pages 14-17 are November 3, 1999. All of these dates pre-date the applicant's invention and have been used as 103 references. The Examiner has cited the explicit pages and paragraphs for each of the limitation for which InoNet was used as the rejection. Thus, applicant is aware of each date for which the InoNet reference is used. Since the pages and

paragraphs have been pointed out to the applicant in the rejection, the applicant can readily see what date is applied to what limitation.

Furthermore, the Examiner does not find disclosure for a fee collection system on page 12, line 12, as applicant states. Line 30 states that in ***an Internet embodiment, people could subscribe to one or all services by paying a fee***. There is no disclosure for a fee collection system or that the fees are paid using the Internet. **Moreover, the Examiner makes note of the applicant's admission that it is well known in the art that when paying fees using the Internet, a fee collection system would have to be used.**

The applicant argues that a proposal and a "problem needing a solution" are not the same. The Examiner expressly addressed this in the rejection above. Furthermore, the applicant states on page 27 of the specification *[t]he "Problem Formulation" field stores a short synopsis of the reasons or motivation for the patent idea. In order to make the system user-friendly, the problem formulation can have bullet categories to choose from, such as "a need for", "a lacking".*

Applicant argues that the Examiner rejected claim 52 as being anticipated by Collective Magic. Claim 52 was rejected as being anticipated by InoNet.

Conclusion

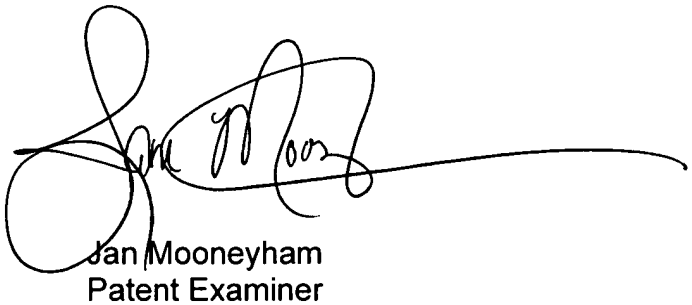
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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